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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,641	02/21/2002	Andreas N. Dorsel	10971150-2	9857

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AGILENT TECHNOLOGIES, INC.
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EXAMINER	
WILDER, CYNTHIA B	

ART UNIT	PAPER NUMBER
1637	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/080,641	DORSEL ET AL.	
	Examiner	Art Unit	
	Cynthia B. Wilder, Ph.D.	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *32,33,36-38 and 43-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *32,33,36-38 and 43-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's amendment filed on February 4, 2004 is acknowledged and has been entered. Claims 1-31, 34, 35 and 39-42 have been canceled. Claims 32 and been amended. Claims 50-52 have been added. Claims 32-52 are pending and discussed below. All of the amendments and arguments have been thoroughly reviewed and considered but are deemed moot in view of the new grounds of rejections. Any rejection not reiterated in this action has been withdrawn as being obviated by the amendment of the claims.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Previous Rejections

3. The claim objection to claim 38 is withdrawn in view of Applicant's amendment of claim 38. The prior art rejections under 35 USC 102(b) directed to claims 32-33, and 37 are withdrawn in view of Applicant's amendment of claim 32. The prior art rejections under 35 USC 102(e) directed to claims 32-38 are withdrawn in view of Applicant's amendment to claim 32.

New Ground(s) of Rejections

THE NEW GROUND(S) OF REJECTIONS WERE NECESSITATED BY APPLICANT'S AMENDMENT OF THE CLAIMS:

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

7. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peters (6,118,532, filing date March 30, 1998) in view of *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). Regarding claim 38, Peters teaches an apparatus for interrogating an addressable array (location) of multiple features (samples) of different moieties, comprising: (a) a seat which can retain an array unit carry the array, in a position for interrogation; (b) a detector system which can collect light at multiple different positions around a cone having an apex at a seated array (see abstract and figure 4). Peters et al do not teach a processor as claimed. However, the Courts have established that merely using a computer to automate a known process

does not by itself impart nonobviousness to the invention (see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)). The Courts have established that if the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine having no functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included a processor to the apparatus of Peters for storage and analysis of signals received from the apparatus based on Court ruling involving *In re Venner*.

8. Claims 32, 33, 43, 44, 47-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters (US 6,118,532, filing date March 30 1998) as previously applied above in view of Kay (US 3,850,525, November 26, 1974) and further in view of *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). Regarding claim 32, 33, 43, 44, 47-50, Peters teaches an apparatus for determining light scattered by a sample, said apparatus comprising an adjustable detection angle detector system which as more than one detector (plurality of detectors) and a light source to provide an interrogating light source, wherein said light source is a laser (col. 2, lines 42-50 and col. 3, lines 66-67 to col. 4, lines 1-3). Peters teaches wherein the detector is a photomultiplier or photodiode (col. 3, lines 50-51). Peters teaches that the apparatus comprising an adjustable detection angle detector system whereby the plurality of detectors are utilized to allow for simultaneous measurements of a sample in a solution from a plurality of angles and allows for simple but accurate adjustments of the detector (col. 2, lines 30-56). Peters differs from the instant invention in that Peters does not expressly teach that the adjustable detection

angle detector system comprising the plurality of detectors detect different emitted light wavelength at the respective different detection angles. Kay teaches an apparatus comprising: an interrogating light source, wherein said light source is a laser which is capable of generating multiple beams of light to detect emitted light at different wavelength or polarizations at different detection angles (see abstract; summary of invention beginning at col. 4 to col. 5 and figure 1). Kaye teaches the apparatus allows for the simultaneous measurement of scattered light at different angles and different wavelengths which permits the simultaneous determination of particle size and DNA content (col. 5, lines 44-62). Neither Peters nor Kaye teach a processor as claimed. However, the Courts have established that merely using a computer to automate a known process does not by itself impart nonobviousness to the invention (see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)). The Courts have established that if the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine having no functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included a processor to the apparatus of Peters in view of Kaye for storage and analysis of signals received from the apparatus based in Court ruling involving *In re Venner.*

9. Claims 36, 37, 45, 46, 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters in view of Kaye as previously applied above in view of Roustaei (US 6, 123, 261, Effective filing date May 5, 1997) and further in view of *In re Venner*, 262 F.2d 91, 95,

120 USPQ 193, 194 (CCPA 1958). Regarding claims 36, 37, 45, 46, 51 and 52, Peters teaches an apparatus for determining light scattered by a sample, said apparatus comprising an adjustable detection angle detector system which as more than one detector (plurality of detectors) and a light source to provide an interrogating light source, wherein said light source is a laser (col. 2, lines 42-50 and col. 3, lines 66-67 to col. 4, lines 1-3). Peters teaches wherein the detector is a photomultiplier or photodiode (col. 3, lines 50-51). Peters teaches that the apparatus comprising an adjustable detection angle detector system whereby the plurality of detectors are utilized to allow for simultaneous measurements of a sample in a solution from a plurality of angles and allows for simple but accurate adjustments of the detector (col. 2, lines 30-56). Peters differs from the instant invention in that Peters does not expressly teach that the adjustable detection angle detector system comprising the plurality of detectors detect different emitted light wavelength at the respective different detection angles. Kay teaches an apparatus comprising: an interrogating light source, wherein said light source is a laser which is capable of generating multiple beams of light to detect emitted light at different wavelength or polarizations at different detection angles (see abstract; summary of invention beginning at col. 4 to col. 5 and figure 1). Kaye teaches the apparatus allows for the simultaneous measurement of scattered light at different angles and different wavelengths which permits the simultaneous determination of particle size and DNA content (col. 5, lines 44-62). Neither Peters nor Kaye teach a processor as claimed. Likewise, the references do not teach a reader to read a code and a scanning system which scans the interrogating light. Roustaei et al teaches an optical scanning device system for reading and/or analyzing encoded information; said device may be build into a fixed scanning station or may be portable. Roustaei teaches that the device comprises a scanner, reading device

and processor which functions to decode and read symbols having a wide range of features and processing said symbols (col. 3 to col. 5 and abstract). However, these features of a reader, scanner and processor, which are all involved in receiving, processing and storing signals from an apparatus does not by themselves impart nonobviousness to the invention. The Courts have established that merely using a computer to automate a known process does not by itself impart nonobviousness to the invention (see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)). The Courts have established that if the difference between the prior art and the claimed invention is limited to descriptive material stored on or employed by a machine having no functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included a scanner, reader and processor as taught by Roustaei to the apparatus of Peters in view of Kaye for analysis and storage of signals received from the apparatus based in Court ruling involving *In re Venner.*

Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bachalo (US 4,854,705, August 1989) teaches method and apparatus to determine the size and velocity of particles using light scatter detection from a light source having different wavelengths and polarization at different respective detection angles.

Conclusion

11. No claims are allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia B. Wilder, Ph.D. whose telephone number is (571) 272-0791. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be emailed to cynthia.wilder@uspto.gov. Since email communications may not be secure, it is suggested that information in such request be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Cynthia Wilder

CYNTHIA WILDER
PATENT EXAMINER